REMARKS

Claims 1-25 and 28-36 stand rejected. Claims 1, 13, and 17 have been amended. New claims 37-40 have been added. Claims 1-25, and 28-40 are presently pending. No new matter has been added by the present amendment. The amended and new claims are supported by the original specification and figures. In view of the foregoing amendments and the following remarks, Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested.

1. Rejection of claims 1, 3-5, 8-10, 13, 16, 17, 20, 24 and 25 (35 U.S.C. § 102(b))

Claims 1, 3-5, 8-10, 13, 16, 17, 20, 24 and 25 stand rejected under 35 U.S.C. § 102(b), the Office Action indicating they are anticipated by U.S. Patent No. 5,249,801 to Jarvis ("Jarvis"). Claims 1 was amended to correct a formalities error without changing its scope, so that the recited "game" matches its antecedent "single game".

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. M.P.E.P. § 2131. Claim 1 recites

> ... gaming information coupled to the substrate, the gaming information including a random request region corresponding to a *single* game, wherein the random request region corresponding to the single game enables a plurality of computer-generated picks to be requested for the single game.

The Office Action, on page 3, last paragraph admits that "Jarvis fails to disclose that a plurality of quick picks may be selected for a single game". Jarvis generally describes a lottery playing card having rows or arrays of numbers. The numbers can be circled by a player to identify a game selection, for example a set of numbers. The player in Jarvis can also automatically select a *single* random set of numbers for a *single game* without actually having to pick his or her own numbers by filling in Jarvis box 26. The "easy pick" box 26 described by Jarvis allows a player to select only *one pick for one game*. Even when several different elements 26 are combined into a single object, as argued by the Examiner, Jarvis

still does not teach or suggest "random request region corresponding to a *single* game" that "enables a plurality of computer-generated picks to be requested for the single game" because each of elements 26 in Jarvis corresponds to a distinct or different game. *See* Jarvis, col.3, lines 8-11. Thus there is no random request region in Jarvis which allows the selection of a plurality of picks for a *single* game. Accordingly, claim 1 is not anticipated by Jarvis.

Similar arguments apply to independent claims 13 and 17 which have also been similarly amended. Thus, Applicant respectfully submits that Claims 1, 13 and 17 should be allowable over Jarvis. Claims 3-5, 8-10, 16, 20, 24 and 25 are each ultimately dependent on one of Claims 1, 13 and 17. Therefore, Applicant submits that Claims 3-5, 8-10, 16, 20, 24 and 25 are allowable for at least the same reasons as their respective parent claims. Withdrawal of the rejection under 35 U.S.C. 102(b) is respectfully requested.

The Examiner comments regarding claims 17 and 20 that the recited machine-readable medium is "to store" a set of instructions. This comment is not understood, as the preamble of claim 17 expressly recites that an article of manufacture "having stored thereon" instructions. Further clarification is respectfully requested.

2. **Rejection of claims 1,3-5,8-10,13,16,17,24,25, and 28 over Jarvis in view of Novak (35 U.S.C. § 103(a))**

Independent claim 1 recites a "random request region" that "enables a plurality of computer-generated picks to be requested for the single game." As indicated in the Office Action, Jarvis fails to disclose this feature. To correct the defects of Jarvis, the Office Action proposes a combination of Jarvis with Novak. Novak's Figure 4 purports to describe a computer generated "pick slip" which includes two quick picks.

The fact that references can be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability of the combination or modification. *See* MPEP 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). Neither Jarvis nor Novak can be fairly said to suggest the desirability of the Office

Action's proposed modification of Jarvis. Applicant respectfully submits that the proposed combination of Novak and Jarvis is a pure hindsight reconstruction, using Applicant's claim 1 as a map.   Nothing in either Novak or Jarvis suggests that Novak's multiple quick picks, *which are selected by pushing buttons,* should be grafted onto Jarvis's manually completed slip to "increase the chances of winning." The alleged reason for combining the references "for the purpose of allowing the user to easily generate a plurality of picks for a game, thereby increasing the chances of winning" is not a motivation to make the particular combination discussed in the Office Action at all. In fact, both Novak and Jarvis already have multiple ways to win of various sorts, and nothing in either reference suggests that this particular combination should be made for "increasing chances of winning". An ordinary artisan would not be lead to provide the recited "random request region" enabling a plurality of computer-generated picks to provide "increasing chances of winnings", as both references already provide multiple ways to win prizes. Increasing the chances of winning would far more simply be provided by altering the odds or piece sets in the game. Thus, "increasing the chances to win" is not a motivation to combine the references to produce the claimed invention; rather the Office Action is merely following the path revealed by Applicant's claim.

Applicant also respectfully submits that an ordinary artisan would not have been lead to combine Novak with Jarvis to produce the Applicant's claimed invention, because the references fundamentally differ in how they operate. In particular, Novak teaches a *computer-generated* pick slip, e.g., a slip generated by pushing buttons at the terminal shown in Novak's Figure 3. In contrast, Jarvis describes a gaming slip that is filled out *by hand.* Thus, while Novak describes a pick slip which appears to be used to obtain multiple quick picks, Novak generates his pick slip with a terminal. Thus, Novak does not teach or suggest that a gaming slip that is filled out *by hand* should modified to allow for multiple quick picks in a single random request region, as recited in Applicant's claim one. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. MPEP 2243.01 (citing *In re Ratti*, 270 F.2d 810

(CCPA 1959)). To incorporate Novak's approach to multiple quick picks into Jarvis would require fundamentally altering the manual nature of Jarvis' game entry, to replace it with an automated system like the one used in Novak. Moreover, Novak, does not provide the slightest suggestion that this modification should be made, or how this modification should occur in a manual gaming slip like the one in Jarvis.

Finally, in the pick slip shown in Novak's Figure 4, element 64 is not "a random request region" even though it says "Quick Pick". The fields in element 64 are merely present to show a player information about the pick slip, not to enable quick picks to be requested. In Novak, the bar code is what is scanned by the system to determine what sort of ticket a customer with the pick slip wishes to purchase. Novak, teaches away from the proposed combinations with Jarvis, because game entries are made with Novak's slip with a *single* machine readable bar code, *not* separate random request regions. Novak's use of a single machine readable code, teaches away from any combination with Jarvis, with multiple manual entry areas.

Claims 3-5, 8-10, 24-26, and 28 ultimately depend from claim 1, and thus should be allowable for at least the reasons given above for claim 1.

Independent claim 13 was amended to correct informalities, so that antecedent basis is more clear. Claim 13 recites "reading a random request region of the gaming slip, the random request region corresponding to a single game; and generating a plurality of picks for the single game, the number of picks based on information read from the random request region." This claim should be allowable for reasons similar to those discussed above for claim 1.

Claim 16 depends from claim 13, and thus should be allowable for at least the reasons given above for claim 13. Claim 17 should be allowable for reasons similar to claim 13, which has identical recitations in method claim form.

3. <u>Rejection of claims 2, 6, 7, 11, 12, 14, 15, 18, 19, 29-33, and 35-36 over Jarvis in view of Novak, and further in view of Alvarez (35 U.S.C. § 103(a))</u>

Claim 2, 6, and 7, 29-33, 35 and 36 depend ultimately from claim 1, and thus should be allowable for at least the same reasons given above for claim 1. The addition of Alvarez does not correct the defect in the cited combination of Jarvis and Novak. Moreover, Applicant also respectfully submits that the proposed combination is improper. Nothing in Alvarez, Jarvis, or Novak teaches or suggests the proposed motivation to combine, that the multi-game card of Alvarez should be applied to Jarvis' game "for the purpose of allowing a user to easily select numbers for different types of games." There is nothing cited that teaches or suggests that an ordinary artisan would be motivated to provide different types of games in Jarvis.

Claim 11, recites "a plurality of game panels" each "corresponding to a different game" and each having "a random request region enabling a plurality of computer-generated picks to be requested for the respectively corresponding game." As discussed above for claim 1, neither Jarvis, nor Novak, nor their combination teach a random request region of this sort. The addition of Alvarez does not correct the defect in the cited combination.

Claim 12 depends from claim 11, and therefore should be allowable for at least similar reasons.

Claim 14 recites "each random request region corresponding to a different type of game" and generating a number of picks based on information read from the random request region. This claim should be allowable for reasons similar to those discussed above. Claim 15 depends from claim 14 and therefore should be allowable for at least similar reasons. Claim 18 recites identical language with corresponding method claim 14, and should therefore be allowable for similar reasons. Claim 19 depends from claim 18 and should be allowable for at least the same reasons.

4. **Rejection of claims 21-23 and 34 over Jarvis in view of Novak, and further in view of Alvarez and Alexoff (35 U.S.C. § 103(a))**

Claims 21-23 and 34 stand rejected under 35 U.S.C. § 103(a), over Jarvis in view of Novak, and in further view of Alvarez and Alexoff. Claim 21 recites in part:

> gaming information coupled to the substrate, the gaming information including a random request region corresponding to a game, wherein the random request region enables a plurality of computer-generated picks to be requested for the game,
> the random request region corresponding to the game comprises a plurality of boxes, and wherein the number of computer-generated picks for the game is indicated by marking one of the plurality of boxes.

Claim 21 should thus be allowable for at least similar reasons as claims 1 and 11 discussed previously. Moreover, claim 21 recites the random request region comprises a plurality of boxes, a feature which the Office Action comments is not found in Jarvis, or Jarvis modified in view of Novak and Alvarez. To correct this admitted deficiency, the Office Action proposes a four-way combination with Alexoff.

As an initial matter, the proposed combination does not yield the claimed invention, because Alexoff does not provide the required feature of a plurality of boxes wherein the number of computer-generated picks for the game is indicated by marking on the plurality of boxes. The Office Action cites the discussion Alexoff 4:11-16 as allegedly describing this missing feature. However, Alexoff 4:11-16 does not discuss Alexoff's playslip – rather it discusses Alexoff's game ticket shown in Alexoff Figure 3. Thus the cited portion of Alexoff is not dealing with any sort of a request region, that enables the request of picks. With respect to Alexoff's playslip, Alexoff does not describe the "number of plays" area shown on the playslip as indicating multiple plays for a particular quickslip box. Rather, it appears that the "number of plays" merely confirms how many columns on the playslip that the prospective player has completed. To obtain multiple quick picks, each separate quick pick box would still need to be checked. *See* Alexoff 4:41-43. Thus, Alexoff does not provide the required missing feature. For at least this reason, claim 21 is not obvious over the proposed combination.

The proposed combination also does not render claim 21 obvious because the Office Action does not provide a proper motivation to combine the references to produce the claimed invention. The Office Action posits that "providing instant gratification to a user" is a motivation to make the proposed four way combination. Applicant respectfully disagrees. An ordinary artisan would not be led to provide boxes indicating a plurality of random picks should be provided to provide "instant gratification" to a user. The proposed motivation to combine or modify does not seem to be fairly interpreted to lead to the proposed combination, let alone Applicant's claimed invention. Moreover, similar to what was discussed previously with respect to Jarvis, Novak, which uses machine-generated entry slips, teaches away from the proposed combination with a manual entry slip of Alexoff. Accordingly, Applicant submits that the proposed combination does not render claim 21 obvious, and respectfully requests withdrawal of the rejection.

Claim 22 and 23 depend from claim 21 and therefore should be allowable for at least the same reasons. Claim 34 depends from claim 2, and therefore should be allowable for at least the same reasons as claim 2. Moreover, claim 34, includes recitations similar to claim 21, and therefore should be allowable for reasons similar to those discussed above for claim 21.

5. New Claims 37-40

New claims 37-40 depend from various claims discussed above, and therefore should be allowable for at least the same reasons as those given above for their respective parent claims. Moreover, claims 37-40 all recite "the random request region corresponding to the single game includes a marking area, the random request region enabling the plurality of computer-generated picks to be requested for the single game by marking the marking area with a writing instrument" or have similar recitations. This added language should further distinguish these claims from any combination based on the machine-generated pick slip of Novak.

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon LLP Deposit Account No. 11-0600.

Respectfully Submitted,

KENYON & KENYON LLP

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